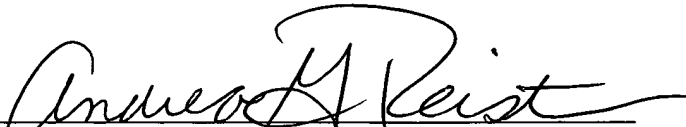




TRANSMITTAL OF APPEAL BRIEF			Docket No. 016762.085-US01	
In re Application of: Richard J. Collins, et al.				
Application No. 09/611,320	Filing Date July 6, 2000	Examiner W. Fridie	Group Art Unit 3722	
Invention: CARD WITH INCREASED GRIPABILITY				
<p style="text-align: center;"><b><u>TO THE COMMISSIONER OF PATENTS:</u></b></p> <p>Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>September 20, 2002</u></p> <p>The fee for filing this Appeal Brief is <u>320.00</u></p> <p><input checked="" type="checkbox"/> Large Entity      <input type="checkbox"/> Small Entity</p> <p><input checked="" type="checkbox"/> A check in the amount of <u>320.00</u> is enclosed.</p> <p><input type="checkbox"/> Charge the amount of the fee to Deposit Account No. _____ This sheet is submitted in duplicate.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-0740</u> This sheet is submitted in duplicate.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 50px;"><div style="width: 60%;"> Andrea G. Reister Attorney Reg. No. 36,253 COVINGTON &amp; BURLING 1201 Pennsylvania Avenue, N.W. Washington, DC 20004-2401 (202) 662-5141</div><div style="width: 35%; text-align: right;"><p>Dated: <u>November 19, 2002</u></p></div></div>				

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#  
Brief on Appeal  
S. Zimmerman  
11-22-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of )  
Collins, *et. al* )  
Assignee: Bank of America Corp. )  
Serial Number: 09/611,320 )  
Filing Date: July 6, 2000 )  
For: Card with Increased )  
Gripability )

Art Unit: 3722  
Examiner: W. Fridle

**BRIEF ON APPEAL**

Commissioner for Patents  
Washington, DC 20231

Sir:

The following appeal brief is submitted pursuant to the Notice of Appeal filed on September 20, 2002 in the above-captioned application. A request for Oral Hearing was also filed on September 20, 2002. It is not believed that extensions of time are required. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740 referencing docket number 016762.085-US01.

**I. REAL PARTY IN INTEREST**

Bank of America Corporation is the assignee of the above-captioned application, and is the real party in interest.

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## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

Claims 24-33 are the only claims pending. Claims 1-23 have been cancelled. All of claims 24-33 stand rejected, and all are the subject of the instant appeal. Claims 24-33 have been twice rejected, once in Paper No. 7 dated August 28, 2001, and once in the Office Action dated May 21, 2002. This appeal is taken from the second rejection of May 21, 2002, in accordance with 37 C.F.R. § 1.191.

## **IV. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the May 21, 2002 rejection.

## **V. SUMMARY OF INVENTION**

The present invention is directed to a credit-card-sized card with a plurality of craters that form a tread disposed on a face of the card. Each crater comprises a lip and a center, with the lip being raised slightly above the face of the card and the center being indented slightly into the face of the card.

The present invention is particularly useful when a number of cards are held in sleeves within a wallet or carrying case. In such circumstances, the cards are often held very

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tightly within each sleeve, making it difficult remove and use a particular card. The use of craters disposed on the face of a card improves the gripability of that card, making it easier for a user to retrieve it from the wallet or carrying case.

FIGs. 4A-4C (*see* Exhibit A) show a number of embodiments of the present invention. In each of these embodiments, dimples 17 are arranged in various ways to form treads 16 on the face of a card 32. In certain embodiments, the dimples 17 are arranged in triangular or linear patterns, and are positioned near the edges of the card 32, to facilitate the removal of the card 32 from a wallet or carrying case. Of course, the particular arrangements shown in FIGs. 4A-4C are simply representative, and other arrangements should be apparent to one skilled in the art.

FIG. 5D (*see* Exhibit A) shows an embodiment of a crater structure for the dimples 17. In such an embodiment, the crater has a center that is indented slightly into the face of the card, and a lip that is raised slightly above the face of the card. Such craters disposed on the face of the card enhance the ability of a user to grip and remove the card from wallets, carrying cases, and the like.

## VI. ISSUES

In the rejection dated May 21, 2002, the Examiner cited two patents -- U.S. Patent No. 5,096,228 ("the Rinderknecht patent") (Exhibit B) and U.S. Patent No. 5,556,092 ("the Theken patent") (Exhibit C) -- in rejecting claim 24, the only pending independent claim. The Examiner asserts that the present invention results from a combination of the Rinderknecht and Theken patents and that such a combination would have been obvious to

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one with ordinary skill in the art. Accordingly, the Examiner rejected independent claim 24 under 35 U.S.C. § 103 as being unpatentable over a combination of these two patents. Thus, the issue presented is whether the present invention is the result of the combination of the Rinderknecht and Theken patents, and whether such combination would have been obvious to one having ordinary skill in the art.

### **VII. GROUPING OF CLAIMS**

Appellant respectfully submits that all claims contain patentable subject matter, and that no claim should fail for obviousness under 35 U.S.C. § 103. Claims 24-33 stand or fall together.

### **VIII. ARGUMENT**

#### **A. There Is No Motivation To Combine The Rinderknecht And Theken Patents.**

The present invention is directed to solving the problems associated with gripping a card, such as a credit card, to remove it from a wallet, carrying case, and the like. The present invention is directed to a credit-card-sized card with a plurality of craters disposed on a face of the card. Each crater has a center indented slightly into the face of the card, and a lip raised slightly above the face of the card. This arrangement increases the gripability of the card.

The Examiner has rejected claims 24-27 and 29-33 under 35 U.S.C. § 103 as being unpatentable over the Rinderknecht and Theken patents. The Examiner rejected claim 28 under § 103 as being unpatentable over the Rinderknecht and Theken patents, and further

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in view of U.S. Patent No. 4,443,027 to McNeely *et al.* ("the McNeely patent"). However, as noted above, all claims stand or fall together, and thus this brief will address only the rejection of independent claim 24 based on the Rinderknecht and Theken patents.

When rejecting pending claims, the Examiner must evaluate the prior art "ascertaining the facts fairly disclosed therein *as a whole*." *In re Meng and Driessen*, 181 U.S.P.Q. (BNA) 94, 97 (C.C.P.A. 1974) (emphasis added). After examining the Rinderknecht and Theken patents as a whole, it is apparent that neither patent suggests a motivation to combine their teachings.

As stated by the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." An examiner can satisfy the burden of obviousness in light of a combination only by showing some objective teaching leading to the combination. *See id.*; *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). The examiner has not provided any objective teaching leading to the combination of the Rinderknecht and Theken patents.

The Rinderknecht patent discloses a card in which a non-slip engaging means is an impression recessed within the surface of the card. *See* col. 4, lines 23-25; FIG. 7. The non-slip engaging or withdrawal means 16B is an impression received within the surface of the card. Thus, the Rinderknecht patent teaches an impression on the surface of the card to be gripped. It appears that this embodiment of the Rinderknecht patent also contains a slight protrusion on the surface of the card opposite the impression. Because this slight protrusion

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of the card in the Rinderknecht patent appears on the non-gripped side of the card, it does not improve the gripability of the card. Moreover, the Rinderknecht patent makes clear that the impression is the non-slip engaging or withdrawal means. *See* col. 4, lines 23-25.

That the Rinderknecht patent does not disclose or suggest the crater structure of independent claim 24 is made clear by the Examiner's allowance of claims 24-33 over the Rinderknecht patent in the Final Office Action dated January 29, 2002. Moreover, the Examiner recognizes on page 3, paragraph 5 of the Office Action dated May 21, 2002 that the Rinderknecht patent does not disclose a plurality of craters that form a tread.

The Examiner cites the Theken patent on page 3, paragraph 5 of the Office Action dated May 21, 2002 as allegedly teaching "that it is well known in the art to use a plurality of craters (30,32) to form treads." The Examiner then makes a conclusory statement that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the notch (16) of Rinderknecht with craters as taught by Theken in order to increase the gripability." Appellant respectfully disagree with this conclusory statement of the Examiner for at least the following reasons.

As described in column 2, line 40 to column 3, line 8, the Theken patent is directed to an ergonomic handle suitable for use as an industrial tool handle, sports racquet handle, or a medical instrument. The handle grip has a series of concentric ridged areas (12, 14, 16) separated by gripping valleys (30, 32). The valleys include oval or elliptically shaped dimples. The first set of dimples 30 is aligned with the long axis running in the direction of the long axis of the handle, and there are generally from about 4 to about 8, most preferably about 6 dimples arranged around the circumference of the grip.

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Thus, the Theken patent is directed to problems associated with grasping a handle of a sports racquet or a surgical instrument with the whole hand. The ergonomic handle of the Theken patent has gripping features around the circumference of the handle to facilitate grasping by the whole hand. In contrast, the Rinderknecht patent is directed to problems associated with gripping a card, using an impression on one surface of the card to remove it from a wallet, carrying case, or the like. As shown in FIG. 2 of the Rinderknecht patent, this is typically done with one or two fingers.

As stated by the Federal Circuit in *In re Werner Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000), a rejection cannot be predicated on the mere identification of individual components of claimed inventions. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

When considering the Rinderknecht and Theken patents as a whole, it is clear that the Rinderknecht patent is directed to gripping a card to remove it from a wallet or the like, while the Theken patent is directed to gripping a handle for playing sports or conducting surgery. The Examiner has provided no reasons why one skilled in the art, given the teachings of the Theken patent regarding ergonomic handles for sports and surgery would use such a structure to solve problems relating to gripping a card as taught in the Rinderknecht patent. That this is the case is reinforced by the Examiner's inability to cite any objective teaching, other than gripping generally, in either patent to support the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

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make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1783-84 (Fed. Cir. 1992).

Thus, the Examiner has not provided any objective teaching leading to the combination of the Rinderknecht and the Theken patents. As such, the rejection under 35 U.S.C. § 103 cannot properly be maintained.

**B. Even If A Combination Of The Rinderknecht And Theken Patents Were Possible, The Result Is Not The Claimed Invention**

As discussed above, the Rinderknecht and Theken patents cannot properly be combined. Assuming, *arguendo*, that the teachings of the Rinderknecht and Theken patents are combined, the claimed invention does not result. Because neither the Theken patent nor the Rinderknecht patent discloses the crater structure as claimed, a card comprising the claimed crater structure cannot result from a combination of these two patents.

Independent claim 24 requires that one of the faces of the card comprises a plurality of craters, with each crater comprising a lip raised slightly above the face of the card, and a center indented slightly into the face of the card. As noted above, the Examiner concedes that such a structure is not disclosed or suggested in the Rinderknecht patent. As such, the Examiner is relying on the Theken patent as teaching the crater structure as claimed. Particularly, the Examiner refers to "craters" (30,32) in the Theken patent. Appellants respectfully submit that dimples 30, 32 disclosed in the Theken patent are not craters as claimed. As shown and described in the Theken patent, the gripping valleys include oval or elliptically shaped dimples 30, 32 arranged around the circumference of the grip. Such valleys do not include the lip aspect of the claimed crater structure.

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Moreover, Appellant respectfully submits that even if the combination of the ridge (12, 14, 16) and valley or dimples (30, 32) structure disclosed in the Theken patent is considered, this combination is not a crater as claimed. As shown in Figure 1 and described at column 2, line 40 through column 3, line 8 of the Theken patent, the handle has a series of concentric ridged areas separated by gripping valleys. This is distinct from the crater structure as claimed with a lip raised above the face of the card and a center indented into the face of the card. The difference can readily be seen by comparing Figure 1 of the Theken patent with Figure 5D of the present application (*see* Exhibit A). In the handle of the Theken patent, the combination of concentric ridges 12, 14, 16 and dimples 30, 32 does not form a structure having a lip raised above a surface, with a center indented into that same surface. As such, Appellant respectfully submit that the ridges and dimples taught in the Theken patent does not disclose or suggest the crater structure as claimed.

Further, the Rinderknecht patent teaches the use of an impression as the withdrawal means, any protrusion being on the non-gripped side of the card opposite from the impression. As such, there is no motivation given these teachings to modify the impression 16B of the Rinderknecht card to include the protruding ridges as taught by the Theken patent. Moreover, if the Rinderknecht card were to be modified to include the protruding ridges, any such protrusion would have to be on the side of the Rinderknecht card opposite from the impression 16B. Even if such a modification could be considered proper, it does not result in the crater structure as claimed.

For at least the foregoing reasons, a combination of the Rinderknecht and Theken patents does not result in the invention as recited in independent claim 24. The

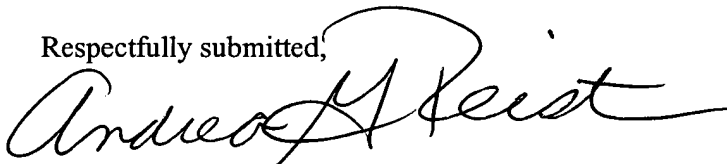
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combination does not disclose or suggest the crater structure as claimed. Therefore, the rejection based on the Rinderknecht and Theken patents cannot properly be maintained for independent claim 24, or the more narrow claims depending therefrom.

**CONCLUSION**

Independent claim 24 recites a card having a plurality of craters disposed on a face of the card, with each crater having a center indented slightly into the face of the card, and a lip raised slightly above the face of the card. The subject matter of independent claim 24 should be allowable over the Rinderknecht and Theken patents for at least the reasons discussed above in Sections A and B. In view of the above discussion, Appellant respectfully urges that the rejection of claim 24-33 as unpatentable under 35 U.S.C. § 103 is improper. Reversal of the rejections in this appeal is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrea G. Reister", written over the typed name.

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November 19, 2002

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**APPEAL BRIEF APPENDIX**

24. A credit-card-sized card comprising: a first face, a second face, and a tread comprising a plurality of craters disposed on one of said first and second faces, each of said plurality of craters comprising: a lip and a center, and wherein the lip of each crater is raised slightly above said one face, and the center of each crater is indented slightly into said one face.
25. A card as in claim 24, further comprising a magnetic stripe.
26. A card as in claim 25, wherein the magnetic stripe has approximate dimensions of 12 to 16 mm in width and 82 mm in length, and is located on a back of the card approximately 5 mm from and parallel to a lengthwise edge of said card.
27. A card as in claim 26, wherein the tread avoids interference with the readability of information encoded on the magnetic stripe.
28. A card as in claim 24, further comprising a computer chip embedded in said card for the storage of digital information.
29. A card as in claim 24, wherein said tread is arranged near an edge of said card.
30. A card as in claim 24, wherein said plurality of craters are arranged in at least one triangular pattern.
31. A card as in claim 29, wherein said plurality of craters are arranged in at least one triangular pattern.
32. A card as in claim 24, wherein said tread is formed on a front of said card.
33. A card as in claim 24, wherein said tread is formed on a back of said card.